

Notice of Allowability

Application No.

10/772,799

Examiner

Emily Le

Applicant(s)

BLOOM, JONATHAN DAVID

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 02/05/2004 and 10/11/2006.
2. ☒ The allowed claim(s) is/are 1-12 and 18.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Joseph M. Mazzaresse on January 12, 2007 and January 18, 2007.

The application has been amended as follows:

Claim 7 the recitation "N-{4-[3-(4-aminophenyl)-4-isoxazoly]phenyl}-N'-[1-(4-fluorophenyl)ethyl]thiourea;" , lines 2-3 of claim 7, should be "N-{4-[3-(4-aminophenyl)-4-isoxazolyl]phenyl}-N'-[1-(4-fluorophenyl)ethyl]thiourea;" .

Claim 8: the recitation "A pharmaceutical composition" , line 1, is amended to "A composition" .

Claims 13-17 are cancelled.

2. The following is an examiner's statement of reasons for allowance: Patent and literature searches, which include structure, text and molecular formula searches, show that the compound encompassed by formula (I), as recited in claim 1, is free of the art. Hence, in view of this finding and in accordance with *In re Ochiai* practice, the restriction issued for the instantly pending claims, claims 1-12 and 18, is withdrawn. In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present

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application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

In the examination of the method(s) of using and making the compound encompassed by formula (I), it is found that the methods satisfy the requirements set forth in 35 U.S.C § 112, first paragraph, both the written description and the enablement requirements. Specifically, the method encompassed by claims 9-12 satisfies the written description and the enablement requirements for the *in vitro* inhibition of the replication of a herpes virus comprising contacting a compound of formula (I) or a pharmaceutically acceptable salt thereof with an alpha or beta herpes virus. The method encompassed by claim 18 also satisfies the written description and the enablement requirements for the preparation of the compound of formula (I). In the instant case, the closest prior art for the composition is Armistead et al., WO 97/40028 and Widdowson et al., WO 96/25157. Both Armistead et al. and Widdowson et al. teach phenyl urea and thioureas; however, none of the cited closest prior art teaches any of the compounds encompassed by formula (I), and none provide any motivation or suggestion to modify their phenyl urea and thiourea compounds to those encompassed by the compounds of formula (I). Hence, Armistead et al. and Widdowson et al. neither anticipate the compound of formula (I) nor render the compound of formula (I) obvious.

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3. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Le whose telephone number is (571) 272 0903.


The examiner can normally be reached on Monday - Friday, 8 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce R. Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


E. Le
11/18/07

Bruce R. Campell
Supervisory Patent Examiner
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